

ESTTA Tracking number: **ESTTA583927**

Filing date: **01/27/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | Noodle Time, Inc. |
| Granted to Date of previous extension | 02/05/2014 |
| Address | 8750 NW 36th Street Suite 300 Doral, FL 33178 UNITED STATES |
| Correspondence information | Janet C. Moreira Attorney of Record MAVEN Intellectual Property 5801 Biscayne Blvd Miami, FL 33137 UNITED STATES trademarks@maveniplaw.com, janet@maveniplaw.com Phone:855-636-2836 |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 85920599 | Publication date | 10/08/2013 |
| Opposition Filing Date | 01/27/2014 | Opposition Period Ends | 02/05/2014 |
| Applicant | HODGE, BENNY 122 COUNTRY CLUB DR. GREENWOOD, MS 38930 USX | | |

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Entertainment services in the nature of live musical performances

Grounds for Opposition

| | |
|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |


Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1230609 | Application Date | 04/13/1982 |
| Registration Date | 03/08/1983 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |


| | |
|---------------------|--|
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 042. First use: First Use: 1968/00/00 First Use In Commerce: 1968/00/00 Restaurant Services |


| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1371624 | Application Date | 12/10/1982 |
| Registration Date | 11/19/1985 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1980/03/00 First Use In Commerce: 1980/03/00 SAKE | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1412570 | Application Date | 03/05/1986 |
| Registration Date | 10/07/1986 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1985/12/31 First Use In Commerce: 1985/12/31 WINES, NAMELY, PLUM WINE; AND SPIRITS, NAMELY, SAKE | | |


| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2029115 | Application Date | 04/29/1994 |
| Registration Date | 01/07/1997 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 029. First use: First Use: 1996/08/05 First Use In Commerce: 1996/08/05 edible oils and fats | | |


| | | | |
|-------------------|---------|------------------|------------|
| U.S. Registration | 2119770 | Application Date | 12/06/1996 |
|-------------------|---------|------------------|------------|

| | | | |
|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | 12/09/1997 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA GRILL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1995/12/00 First Use In Commerce: 1995/12/00 restaurant services | | |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2058184 | Application Date | 07/18/1995 |
| Registration Date | 04/29/1997 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA GRILL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1995/12/00 First Use In Commerce: 1995/12/00 restaurant services | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3784161 | Application Date | 09/17/2009 |
| Registration Date | 05/04/2010 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |

| | |
|---------------------|--|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 021. First use: First Use: 1980/12/31 First Use In Commerce: 1980/12/31 Drinking mugs |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3928737 | Application Date | 09/08/2010 |
| Registration Date | 03/08/2011 | Foreign Priority Date | NONE |
| Word Mark | BENIHANA | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 035. First use: First Use: 1971/00/00 First Use In Commerce: 1971/00/00 Franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services | | |

| | |
|-------------|---|
| Attachments | 74521919#TMSN.gif(bytes) 75209551#TMSN.gif(bytes) 74702907#TMSN.gif(bytes) 77829100#TMSN.jpeg(bytes) 85124979#TMSN.jpeg(bytes) NOT - Notice of Opposition - Benny Hunnav2.pdf(64167 bytes) Exhibit 1.pdf(26074 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|--------------------|
| Signature | /Janet C. Moreira/ |
| Name | Janet C. Moreira |
| Date | 01/27/2014 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NOODLE TIME, INC.,
Opposer,

vs.

BENNY HODGE
Applicant.

Mark: **BENNY HUNNA**

Serial No: 85/920,599

Filing Date: May 01, 2013

Publication Date: October 08, 2013

Opposition No.: _____

NOTICE OF OPPOSITION

Pursuant to TBMP § 305.01, Opposer, Noodle Time, Inc., a Florida corporation with a principal address of 8750 NW 36th Street, Suite 300, Doral, FL 33178 (“Opposer”), believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/920,599 on the Principal Register, and hereby opposes registration of said mark. As grounds for opposition, Opposer submits the following:

THE FAMOUS BENIHANA® TRADEMARKS

1. Opposer Noodle Time, Inc. is a Florida corporation having its principal place of business at 8750 N.W. 36th Street, Suite 300, Doral, Florida 33178 (“Opposer”). Noodle Time, by and through its related companies, is the nation’s largest operator of teppanyaki restaurants and the leading Asian themed restaurant chain in the world having served over 100 million meals since 1964. Opposer operates approximately 100 **BENIHANA®** restaurants in the United States, South America, Central America and the Caribbean.

2. Opposer’s predecessors and Opposer have continuously, exclusively, and extensively used the arbitrary and distinctive **BENIHANA®** trademarks in interstate commerce since as early as 1964 in connection with its restaurant and related goods/services.

3. Opposer's goods/services have been highly publicized and by virtue of its promotion, advertising, and continuous use of its **BENIHANA®** trademarks in nearly 100 restaurants, Opposer has acquired much notoriety and a most valuable reputation.

4. Due to its presence and extensive advertising and promotion, the **BENIHANA®** trademarks have acquired enormous value and have become distinctive, famous, and well-known to the consuming public and the trade as identifying and distinguishing Opposer's goods/services.




5. Opposer advertises, promotes, and markets its goods/services through television, radio, print, Internet advertising, and its website located at www.benihana.com.

6. The **BENIHANA®** trademarks have been used by Opposer for almost fifty (50) years prior to Applicant's filing the Subject Application. Opposer's rights in its **BENIHANA®** trademarks were established long before any date on which Applicant may rely.

7. As a result of Opposer's extensive advertising and extensive sales, the **BENIHANA®** trademarks have been and are widely recognized by the public and the trade throughout the United States. The arbitrary and distinctive **BENIHANA®** trademarks identify Opposer as the source of origin of goods/services bearing, sold under, and/or distributed in association with those marks and Opposer enjoys considerable and valuable goodwill in the marks.

OPPOSER'S REGISTRATIONS

8. Opposer is the owner of the following federal trademark registrations for its **BENIHANA®** trademarks:

| <u>Trademark</u> | <u>Registration No.</u> | <u>Goods/Services</u> |
|---|-------------------------|--|
| BENIHANA | US 1,230,609 | Restaurant services. |
| BENIHANA | US 1,371,624 | Sake. |
| BENIHANA | US 1,412,570 | Wines, namely, plum wine; and spirits, namely, sake. |
|  | US 2,029,115 | Edible oils and fats. |
|  | US 2,119,770 | Restaurant services. |
|  | US 2,058,184 | Restaurant services. |
| BENIHANA | US 3,784,161 | Drinking mugs. |
| BENIHANA | US 3,928,737 | Franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services. |

(individually and collectively referred to as “Opposer’s Registrations”). True and accurate copies of the registration certificates are attached hereto as ***Exhibit 1***. Opposer’s Registrations are valid, subsisting, and in full force and effect, and constitute prima facie evidence of the validity of the Opposer’s **BENIHANA®** trademarks depicted in Opposer’s Registrations (the marks shall hereafter be individually and collectively referred to as the “**BENIHANA®** Trademarks”) and of Opposer’s exclusive right to use them in connection with the services identified in Opposer’s Registrations and/or any other services that are deemed related.

9. Opposer's federal registrations for the marks **BENIHANA**, Registration No. 2983575, **BENIHANA GRILL**, Registration No. 2119770, **BENIPAC KANA**, Registration No. 2058184, **BENIHANA** Registration No. 2029115, **BENIHANA** Registration No. 1412570, **BENIHANA** Registration No. 1371624, **BENIHANA** Registration No. 1230609, **BENIHANA OF TOKYO** Registration No. 0940142, and **BENIHANA HERB TEA**, Registration No. 2778343 are incontestable, and thereby constitute conclusive evidence of Opposer's exclusive right to use the marks for the goods/services recited in the registrations, in accordance with 15 U.S.C. § 1065. In addition, the registrations are proof of the inherent distinctiveness of Opposer's **BENIHANA®** Trademarks.

RESPONDENT'S SUBJECT APPLICATION

10. On May 2, 2013, Applicant filed an application to register the service mark BENNY HUNNA, subject of Application Serial No. 85/920,599. Applicants filed its application based upon an intent-to-use (Section 1(b), 15 U.S.C. § 1052(b)) in connection with "Entertainment services in the nature of live musical performances" in International Class 041.

11. To the best of Opposer's knowledge, the name and address of the owner of the Subject Application is: Benny Hodge, 122 Country Club Drive, Greenwood, Mississippi 38930. This information was obtained from the records of the United States Patent and Trademark Office ("USPTO").

12. The Subject Application consists of a mark that is confusingly similar to and dilutive of Opposer's **BENIHANA®** Trademarks and in particular, the incontestable **BENIHANA®** registrations.

13. The Subject Application was published in the *Official Gazette* on October 08, 2013.

14. On October 30, 2013, Opposer requested an extension of time to oppose the Subject Application and said extension was granted to February 05, 2014.

15. Upon information and belief, Applicant had knowledge of Opposer's prior rights to and interest in the **BENIHANA®** Trademarks prior to filing the Subject Application. As a matter of law, Applicant was on constructive notice of Opposer's **BENIHANA®** Trademarks based on Opposer's Registrations and Applicant had such constructive notice before filing the Subject Application.

16. On December 3, 2013, Opposer sent Applicant correspondence putting Applicant on actual notice of its rights in the **BENIHANA®** Trademarks.

17. Given the confusingly similar nature of the parties' marks and the dilutive effect of the BENNY HUNNA Service Mark on the **BENIHANA®** Trademarks, Applicant's use of the BENNY HUNNA Service Mark is likely to cause consumers to mistakenly believe that Applicant's goods/services are approved, endorsed, sponsored, or affiliated by Opposer, or that Opposer is a source of Applicant's goods/services, or that the goods/services of Applicant are in some other way associated with Opposer, all to Opposer's injury and harm.

18. In addition, Applicant's use and registration of the BENNY HUNNA Service Mark is intended to trade on the fame and goodwill of the **BENIHANA®** Trademarks. Applicant's use and/or attempted registration of the mark BENNY HUNNA is likely to cause and has caused dilution of the distinctive quality of the **BENIHANA®** Trademarks, by tarnishment and blurring, in view of Opposer's long prior use of the arbitrary and distinctive **BENIHANA®** Trademarks.

19. The registration of Applicant's marks is inconsistent with Opposer's prior rights in the **BENIHANA®** Trademarks and is inconsistent with Opposer's statutory grant of

exclusivity of use of the registered **BENIHANA®** Trademarks, and would destroy Opposer's investment and goodwill in its **BENIHANA®** Trademarks.

20. There is no issue as to priority. The date of Applicant's Subject Application is subsequent to the issuance date of Opposer's Registrations for the **BENIHANA®** Trademarks listed above and to the first use or filing dates of the **BENIHANA®** Trademarks listed above.

21. Accordingly, Opposer requests that the Subject Application not proceed to registration pursuant to 15 U.S.C. § 1052(d).

COUNT 1: LIKELIHOOD OF CONFUSION

22. Opposer hereby incorporates the allegations contained in Paragraphs 1 through 21 as if fully set forth herein.

23. Opposer has continuously, extensively, and exclusively used the **BENIHANA®** Trademarks since as early as 1964 and has not abandoned the mark.

24. Opposer's use and registration of the **BENIHANA®** Trademarks in the United States for restaurant and franchise services predates the purported use by Applicant. The mark depicted in the Subject Application, as used or intended to be used by Applicant for its goods/services is a reproduction, copy, and colorful imitation of the **BENIHANA®** Trademarks. The BENNY HUNNA Mark is likely to cause confusion, mistake, or deception with regard to the origin of said goods/services and to confuse, mislead, and deceive members of the public into believing that Opposer has allowed, sponsored, approved, or licensed Applicant to provide the applied-for goods/services, or in some way Applicant is connected to or affiliated with Opposer, when it is not. Any such confusion would result in injury or have a direct impact on Opposer's reputation and its ability to market its own goods/services under the **BENIHANA®** Trademarks. Furthermore, any defect, objection, or fault found with Applicant's goods/services marketed

under its BENNY HUNNA Mark would negatively impact and seriously injure the reputation Opposer has established for the goods/services it sells under the **BENIHANA®** Trademarks.

25. Registration of the BENNY HUNNA Mark shown in Application Serial No. 85/920,599 is likely to cause confusion, cause mistake, or to deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

26. By reason of the foregoing, Opposer is likely to be harmed by registration of the Subject Application.

COUNT 2: DILUTION

27. Opposer hereby incorporates the allegations contained in Paragraphs 1 through 21 as if fully set forth herein.

28. The **BENIHANA®** Trademarks are distinctive and famous. They have been in use for nearly 50 years throughout the United States, Central America, the Caribbean and South America, operating nearly 100 restaurants. The **BENIHANA®** Trademarks have been advertised extensively and continuously since Opposer first used its marks and they are well-known to the trade and the members of the consuming public. In addition, one or more of the **BENIHANA®** Trademarks have been registered on the Principal Register with the USPTO since 1971. The public generally associates and identifies the **BENIHANA®** Trademarks with Opposer.

29. Applicant's BENNY HUNNA Mark shown in Application Serial No. 85/920,599 constitutes a dilution of the **BENIHANA®** Trademarks, in violation of 15 U.S.C. § 1125(c), in that Applicant's mark dilutes the distinctive quality of the **BENIHANA®** Trademarks by diminishing Opposer's ability to identify and distinguish its goods/services.

30. By reason of the foregoing, Opposer is likely to be harmed by registration of the Subject Application.

PRAYER FOR RELIEF

WHEREFORE, Opposer respectfully requests that the USPTO enter an order denying registration of Application Serial No. 85/920,599 and that this Opposition be sustained in favor of Opposer.

Dated: January 27, 2014

/s/Janet C. Moreira/
Janet C. Moreira
MAVEN INTELLECTUAL PROPERTY
5801 Biscayne Blvd.
Miami, Florida 33137
Tel: 305.636.2836
Fax: 305.967.7450
E-mail: janet@maveniplaw.com

Attorney for Opposer
NOODLE TIME, INC.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing document has been served on Applicant in the following manner:

By E-Mail and Mail

Benny Hodge
122 Country Club Drive
Greenwood, Mississippi 38930
bennyhodge25@yahoo.com

/s/Janet C. Moreira

Janet C. Moreira, Esq.

EXHIBIT 1